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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,301	05/29/2001	Robert H. Scheer	31083.05US4	6151

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GREENBERG TRAURIG, LLP
77 WEST WACKER DRIVE
SUITE 2500
CHICAGO, IL 60601-1732

EXAMINER

JASMIN, LYNDIA C

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,301

Applicant(s)

SCHEER, ROBERT H.

Examiner

Lynda Jasmin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-18 and 20-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-18 and 20-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Amendment received November 13, 2004 has been acknowledged.
2. The indicated allowability of claim 18 is withdrawn in view of the newly discovered reference(s) to Aragones et al. Rejections based on the newly cited reference(s) follow.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 4-18, 20-45 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of copending Application No. 09/867,068. Although the conflicting claims are not identical, they are not patentably distinct from each other because the same end result of moving physical items in a supply chain and creating advance demand notice order that identifies an one or more physical items is achieved.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1, 4-17, 20-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elston (2002/0143655 A1), in view of Aragones et al. (6,832,205).

Elston et al. discloses a method for moving one or more physical items in a supply chain that is distributed over a plurality of geographic locations (via directory for all locations or geographic region for customer places an order with one physical outlet among a group of affiliated merchants for fulfillment) with the steps of:

using a network of intelligent agents (via transaction managers or owner) to move the physical items specified in the advance demand notice within the supply chain (via moving to a pick up location or delivery time designed).

Elston et al. further discloses using an equipment knowledge base (via a remote ordering system). Elston et al. further discloses coordinating with a carrier to move the physical items within the supply chain (inherently recited via order delivery to a customer-selected location or type of transaction: pick up or delivery at customer location). Further, monitoring the movement of the physical items within the supply chain (via the ordering delivery system 40) and forming alternative fulfillment plan (via alternative remote order process flow), ordering product from a supplier to initiate the moving of items within the supply chain (via the remote ordering system), using a customer defined level of service to move the items specified in the advance demand notice (see [00180]), using the current and developing states of inventory within the supply chain to move the items specified in the advance demand notice within the

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supply chain and taking into account a desired level of safety stock when moving the items specified in the advance demand notice within the supply chain (see boxes [0259-0265]).

However Elston fails to explicitly disclose extracting information from a customer maintenance system indicative of a change in a scheduled maintenance work order to create an advance demand notice that includes a specification of one or more physical items.

Aragones et al. discloses the concept of generating service plan forecast for a product that includes time for scheduling service events. Aragones further discloses the concept of determining other life cycle forecast information such as a service contract monitoring program for monitoring the service events listed in a contract, a shop load planning schedule for planning for the future service events of the product, a production planning schedule for scheduling the production of new products, and an inventory management schedule to ensure that there is an inventory of parts to perform the scheduled service events.

From this teaching of Aragones, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the order fulfillment capability of Elston et al. to include the schedule maintenance events taught by Aragones in order to predict timing and cost of future service events of a product.

Further, the Elston and Aragones combination fails to explicitly disclose moving the physical items as a function of a probability of need for each item. However, one of ordinary skill in the art at the time the invention was made would have included the

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probability of need of an item in calculating the optimum scheduling of orders or computation of wait time as disclose in Elston et al. since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Response to Arguments

8. Applicant's arguments with respect to claims 1, 4-18, and 20-45 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dulberg et al. and O'Kane, Jr. et al. are cited for disclosing a method and system of determining maintenance on target or particular equipment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda Jasmin whose telephone number is (703) 305-0465. The examiner can normally be reached on Monday- Friday (8:00-5:30) alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Lynda Jasmin 1/24/05
Primary Examiner
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